

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN M. CARNAHAN III

Appeal 2006-2206
Application 10/743,380
Technology Center 3600

Decided: April 24, 2007

Before BRADLEY R. GARRIS, CATHERINE Q. TIMM and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals the final rejection of claims 1, 2, and 4-11 under 35 U.S.C. § 134. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

INTRODUCTION

Appellant invented a method and a screening device for determining fishing conditions (Specification 1; claim 7). The method includes placing a screening device in the water of a shallow stream such that the screening device spans the distance from the bottom of the stream to the surface of the water (Specification 4). The screening device is left in the water for a period of time to collect organisms on the screen (Specification 4). The screen is removed from the water to inspect the types of organisms and determine the proper fishing lure to use (Specification 4). The screening device comprises two side rails (1 and 3) interconnected by pivotally attached segments (7 and 9) with a screen (17) attached to the two side rails (1 and 3) (Fig. 1 and Specification 7-9). Claims 1, 7, and 8 are illustrative:

1. A method of detecting fishing conditions to allow for selection of a proper fishing lure comprising:

a) providing a screening device having an elongated frame, the elongated frame supporting an elongate screen, the screen attached to the frame to form a curved configuration in use;

supporting the frame whereby a user inserts at least a portion of the frame and screen into shallow water, with the frame oriented so the elongate screen spans a depth of the water near a bottom of the shallow water and close to a surface of the water;

maintaining at least a portion of the frame in the water for a period of time to collect organisms in the water on the screen;

removing the portion of the frame and screen from the water and inspecting the screen for collected organisms; and

selecting the fishing lure based on the organisms collected;

wherein the frame has one or more support portions and one or both of the support portions are embedded in a bed underlying the water as part of the insertion step.

7. A screening device for determining fishing conditions comprising:

a) a frame having a pair of side rails and at least two cross members, the cross members interconnecting the pair of side rails, the side rails include at least one handle portion and one support portion;

b) a flexible screen having opposing ends and opposing sides, each opposing side aligned and attached to a respective side rail, at least one opposing end being a free end and extending between the pair of side rails, the flexible screen having a width such that the free end is curved in shape during use.

8. The screening device of claim 7, wherein each cross member further comprises:

a pair of cross member segments, each segment pivotally attached to a side rail at one end, other ends of each segment pivotally attached together so that the cross member segments and side rails can fold up.

The Examiner relies on the following prior art references as evidence of unpatentability:

Crane	US 1,036,574	Aug. 27, 1912
Flynn	US 5,722,196	Mar. 3, 1998

The rejections as presented by the Examiner are as follows:

1. Claims 1, 2, 4, 7, 9, and 10 are rejected under § 102(b) as being unpatentable over Flynn.
2. Claims 5 and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Flynn.

3. Claims 8 and 11 are rejected under § 103(a) as being unpatentable over Flynn in view of Crane.

Rather than reiterate the respective positions advocated by the Appellant and by the Examiner concerning these rejections, we refer to the Brief and the Reply Brief and to the Answer respectively for a complete exposition thereof.

OPINION

35 U.S.C. § 102(b) REJECTION OVER FLYNN

CLAIM 1: METHOD

Appellant's only argued distinction regarding claim 1 is that Flynn fails to disclose “[the] support portions of the frame are embedded in a bed underlying the water as part of the insertion step” (Br. 12). Appellant contends that laying a “rock or other relatively heavy object on one or both of said support cross members 40 and/or 42”, as Flynn discloses (col. 5, ll. 46-48), “is not the same as embedding the one or more support portions in a bed as part of the insertion step of placing the frame into shallow water” (Br. 12).

We agree with the Examiner that claim 1 is anticipated by Flynn's disclosure.

In making his rejection, the Examiner states that “. . . a heavy object is placed on the device which allows for the portion of the device resting on the waterbed [i.e., stream bed] to be at least partially embedded in the waterbed [i.e., stream bed]” (Answer 4). The Examiner's position appears to be reasonable because, in the normal use of Flynn's aquatic seine device, the bottom support structure of the aquatic seine will inherently become embedded to some extent (e.g., a muddy stream bed would cause a weighted

seine device to at least partially embed in the mud of the stream bed). Appellant bears the burden of showing that such apparently-inherent feature (i.e., embedding) would not actually occur. *In re Best*, 562 F.2d 1252, 1254-55, 195 USPQ 430, 433 (CCPA 1977). Appellant has failed to satisfy this burden.

We further observe that Flynn's Figure 7 shows his device is inserted into a stream such that it rests in the stream bed having rocks and a large rock is placed "... on one or both of said support cross members 40 and/or 42" to hold the aquatic seine in place (Flynn, col. 5, ll. 47-48). In such a support arrangement, it is appropriate to consider the rock(s) on the support cross member(s) as part of the stream bed, so that the rocks embed the support cross members (40, 42).

For the above reasons, we sustain the Examiner's § 102(b) rejection of argued claim 1 and non-argued claims 2 and 4.

CLAIM 7: DEVICE

Appellant's only argued distinction is that Flynn fails to disclose "... a flexible screen with its opposing sides aligned and attached to the side rails ..." (Br. 16). In that regard, Appellant argues that Flynn attaches flexible net 52 to the two parallel vertical members 12 and 14 and not L-shaped horizontal members 16 and 18 (i.e., Flynn's structure corresponding to Appellant's claimed "side rails") (Br. 13-15).

The Examiner states that flexible net 52 is, at least, indirectly attached to the L-shaped horizontal members 16 and 18 (i.e., side rails) via the vertical members 12 and 14 (Answer 7). The Examiner contends that the claim term "attached" "... does not imply ... [or] require that the flexible

screen [i.e., flexible net 52] is directly connected via surface to surface contact with the side rails" (Answer 7).

Appellant counters that "claim [7] calls for the opposing ends of the screen to be attached to the claimed side rails, not just the screen" (Reply Br. 2). Appellant maintains that the "opposing ends of the screen [i.e., Flynn's flexible net 52] are free and unattached" (Reply Br. 2).

We agree with the Examiner that claim 7 is anticipated by Flynn.

Flynn discloses that flexible net 52 is attached to vertical members 12 and 14 (col. 5, ll. 34-36). We note that a first opposing end of Flynn's flexible net is attached to vertical member 12 and the second opposing end is attached to vertical member 14. Flynn discloses that vertical members 12 and 14 are pivotally attached to L-shaped horizontal members 16 and 18 (col. 5, ll. 13-16). Therefore, Flynn's net is indirectly attached to members 16 and 18, i.e., the side rails.

The attachment limitation of the claim encompasses the indirect attachment of Flynn. Appellant states in his Specification that, while pivot pins (13) are shown as attaching the screen (17) to the side rails (1, 3), "other modes of attachment could be used" (Specification, 12: 3-5). Appellant provides an example that includes looping the screen end (19) around the side rails (1, 3) "to form a loop without positive attachment to the [side] rail[s]" (Specification 12: 5-9). From these disclosures, Appellant plainly contemplates that "other modes of attachment" include those that attach the screen (17) to the side rails (1, 3) "without positive [i.e., direct] attachment to the [side] rail[s]" (Specification 12, 3-9).

From Flynn's above-noted disclosures and Appellant's disclosures in his Specification, the Examiner's position is reasonable that flexible net 52

is indirectly attached to L-shaped horizontal members 16 and 18 (i.e., side rails) via vertical members 12 and 14 and that this form of attaching is encompassed by the claim language. Moreover, we are unpersuaded by Appellant's argument that "opposing ends of the screen [i.e., flexible net 52] are free and unattached" (Reply Br. 2). Flynn clearly discloses that two opposing ends of flexible net 52 are attached to vertical members 12 and 14 (col. 5, ll. 34-36).

For the above reasons, we affirm the Examiner's § 102(b) rejection of argued claim 7 and non-argued claims 9 and 10.

35 U.S.C. § 103(a) REJECTION OVER FLYNN IN VIEW OF CRANE
CLAIM 8

Appellant argues lack of motivation for combining Crane's pivotal connection with Flynn's single member cross bar (Br. 17). Appellant contends that Crane does not disclose "each segment has one end pivotally attached to the side rail with each of the other ends of the segments attached together" as claim 8 requires (Br. 17). Appellant determines that Crane uses a "totally different member movement than that contemplated by the invention and Flynn" (Br. 17).

We cannot sustain the Examiner's § 103(a) rejection of claim 8 over Flynn in view of Crane.

Claim 8 requires, in relevant part, that the "other ends of each segment [be] pivotally attached together so that the cross member segments and side rails can fold up." As shown in Appellant's Figure 1, the cross member segments 7 and 9 are pivotally connected via pivot pin 24 so that the user

need only apply pressure to the cross member pivot pin 24 to permit the screening device to fold up (Specification 8).

Crane does not disclose the above-noted pivotal cross member arrangement. Rather, Crane discloses a device where spreaders 6 (i.e., cross members) are pivotally attached to a ferrule 7 (Fig. 1, p. 1, ll. 67-74), not “together” as the required by claim 8. Moreover, Crane’s device requires that the ferrule 7 slidably engage shaft 1 to permit the spreaders 6 (i.e., cross members) to open or close (p. 1, ll. 21-27, 66-77).

Hence, Crane’s device is substantially different in structure and operation from Flynn’s device, such that there would have been no motivation, absent impermissible hindsight, for combining Crane’s pivotally attached spreader 6 (i.e., cross member) with Flynn’s aquatic seine device. Obviousness can not be established by hindsight combination to produce the claimed invention. *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

Accordingly, we reverse the Examiner’s § 103(a) rejection of dependent claim 8 and dependent claim 11, which depends upon claim 8, over Flynn in view of Crane.

35 U.S.C. § 103(a) REJECTION OVER FLYNN

Appellant has not argued the § 103(a) rejection of claims 5 and 6 over Flynn. Accordingly, we summarily affirm the Examiner’s rejection of non-argued claims 5 and 6.

DECISION

The Examiner’s rejection of claims 1, 2, 4, 7, 9, and 10 under § 102(b) over Flynn is AFFIRMED.

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The Examiner's rejection of claims 5 and 6 under § 103(a) over Flynn is AFFIRMED.

The Examiner's rejection of claims 8 and 11 under § 103(a) over Flynn in view of Crane is REVERSED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED-IN-PART

tf/ls

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